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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,630	01/03/2002	J. Blake Scott	72425.0105	6763

110 7590 03/26/2004

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EXAMINER

MARCANTONI, PAUL D

ART UNIT PAPER NUMBER

1755

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,630

Applicant(s)

SCOTT, J. BLAKE

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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Applicant's arguments filed 12/15/03 have been fully considered but they are not persuasive. The examiner has withdrawn rejections under 35 USC 112 as a result of applicants' amendment.

The applicants' amendment necessitated the new grounds of rejection:

New Matter:

Claims 1-20 are rejected under 35 USC 112 first paragraph and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

The newly added limitation of "compressive strength value after seven days of aging is not more than 360 psi" is new matter. It is the examiner's position that the language from applicants' specification indicates that the strength value "need not be more than 360 psi". In other words, it can be higher if so desired and there is no limitation or support that it must be below this strength level. Further, it would not be detrimental having a higher strength value and it would not be a critical difference to the invention. It would seem that having a higher strength for compression would be even more desirable or not have any effect on the instant invention.

It is also note clear whether this strength value of not more than 360 psi holds for all materials (A) quicklime through (H) other pozzolans. It would appear this may be for only one of these components.

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Prior Art Rejection:

Claims 1-20 remain rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hartley et al., Bowlin et al., Hale, Nahm, Sharp, Richardson et al., or Carpenter et al.

Hartley et al. teach mixing drill cuttings and cement or cement kiln dust to form a rigid matrix which is a load bearing structure and would appear to anticipate the instant invention (see claims).

Bowlin et al. teach mixing cement, fly ash, and fumed silica with drill cuttings to form a solid material (see claims).

Hale and Nahm (from Shell Oil Co.) teach mixing drill cuttings with blast furnace slag to form a solid material. Blast furnace slag is a pozzolan and is cementitious so it would appear that these references also anticipate the instant invention.

Sharp teach mixing drill cuttings and lime to form a solidified mixture thus anticipating the instant invention (see claims).

Richardson et al. teach mixing drill cuttings with a solidifier or stabilizer selected from fly ash, lime, cement, and gypsum (see col.3, lines 25-30) and would appear to anticipate the instant invention.

Carpenter et al. teach a composition comprising cement and drilling fluid and would also appear to anticipate the instant invention.

Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. With respect to compressive strength

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values, it is expected that upon curing that these prior art cement compositions would also have an equivalent strength because the process of mixing cement materials with drill cuttings and curing would appear no different.

Response:

The applicants argue that their new limitation of a compressive strength of not more than 360 psi is not met by the prior art. In rebuttal, this has been held to be new matter. Further, even if it is not new matter, page 26 of applicants' specification states that the USC need not be more than 360 psi. It does not state that it cannot be higher nor is there any deleterious effect if it was higher.

The applicants also compare axial compressive strength to unconfined compressive strength. The examiner, however, is not sure these are exactly the same thing and a straightforward comparison. Further, applicants have not presented actual experimental data showing with certainty the difference of their strength values over the prior art.

The applicants next argue the Hale and Nahm patents and state that drilling fluid would appear to be materially distinct from applicants claimed mixture. The examiner disagrees and notes that drilling cuttings would have been part of the drilling fluid. Also, applicants use comprising claim language which would not exclude other components in the drilling fluid. "Comprising leaves the claim open for the inclusion of unspecified ingredients even in major amounts. Ex parte Davis et al., 80 USPQ 448 (PTO Bd of App.1948).

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For the foregoing reasons, the rejection has been held.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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